

Applicant: Hoeffler et al.
Application No.: 09/245,615
Filed: February 4, 1999
Page 4

a³
corel.
-- 59. (New) A kit according to claim 37 wherein the antibodies are monoclonal antibodies, polyclonal antibodies or antibody fragments.

REMARKS

Claims 1-50 were pending before this response. By the present communication, claims 30 and 37 have been amended and new claims 51-59 have been added to define Applicants' invention with greater particularity. These amendments add no new matter as the amended claim language and new claims are fully supported by the specification and original claims.

The Restriction Requirement

The restriction of claims 1-50 under 35 U.S.C. § 121 is respectfully traversed. It is respectfully submitted that the claims have been inappropriately divided. Applicants respectfully submit that the Group I claims (claims 1-17 and 25, drawn to a method for identifying antibodies via antigen binding); the Group II claims (claims 18-24, 26, and 48-50, drawn to methods of comparing protein expression in cell populations); the Group III claims (claims 28-30, drawn to methods of diagnosing a disorder); and Group IV claims (original claims 31-40 and new claims 51-58, drawn to kits comprising antibodies immobilized on a solid surface) could readily be processed together in the same application.

All of the claims in Groups I-IV have the common requirement of "an array of a plurality antibodies located at discrete locations on a solid surface" and all of the pending claims pertain to biological molecules (i.e., antibodies or nucleic acid samples) arrayed on a solid surface. Thus, a search of prior art for claims of any of Groups I-V would necessarily entail search of art that would be searched for the other four groups. In addition, the Group IV kits (see especially claims 32, 36 and 38) are used to practice the Group I methods for identifying antibodies via antigen binding; the Group IV kits (see especially claims 32 and 37) are used in practicing the

Applicant: Hoeffler et al.
Application No.: 09/245,615
Filed: February 4, 1999
Page 5

Group II methods for comparing protein expression in cell populations, and the Group IV kits (see especially claim 37) are used in practicing the Group III methods for diagnosing a disorder.

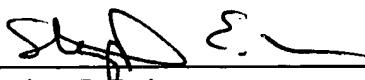
Therefore, it is respectfully submitted that there would be no serious burden on the Examiner to consider all the pending claims together in a single application. Alternatively, at least the claims of Groups I-IV, which all require a plurality of antibodies arrayed on a solid surface, could readily be considered together in a single application. Accordingly, reconsideration of the requirement of restriction is respectfully requested.

In order to be fully responsive, however, Applicants provisionally elect Group IV claims (i.e., original claims 31-40 and new claims 51-59), with traverse. Non-elected claims from Groups I-III and Group V (i.e., claims 1-30 and 41-50) are retained in this application pending final disposition of the elected claims.

In view of the above amendments and remarks, reconsideration and prompt action on the merits with respect to all claims is respectfully requested. Should any questions remain in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

Dated: 7/20/00



Stephen E. Reiter
Registration No. 31,192
Telephone: (858) 677-1409
Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1600
San Diego, CA 92121-2189

LISA HAIL

858
677
1456